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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/509,222

11/09/2004

Koki Ikeda

2004 1539A

5125

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7590

08/07/2006

EXAMINER

BOYKIN, TERRESSA M

WENDEROTH, LIND & PONACK, L.L.P.

2033 K STREET N. W.

SUITE 800

WASHINGTON, DC 20006-1021

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/509,222

**Applicant(s)**

IKEDA ET AL.

**Examiner**

Terressa M. Boykin

**Art Unit**

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 5-30-06; 6-8-06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5-30-06</u> . | 6) <input type="checkbox"/> Other: _____  |

### **Priority**

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-33 are rejected under 35 U.S.C. 102(a, b or e) as being anticipated by JP (EPO) 11306823 abstract; EP 1045261 abstract; WO 01/73780 abstract; EP 1195758 abstract; EP 0722099 abstract; JP 02304741 ; WO 01/11612 .**

The reference **JP (EPO) 11306823** discloses heat resistance and surface appearance and improve the metal evaporating property by providing a lamp lens reflector formed of a polycarbonate copolymer, consisting of specified quantities each of 9,9-bis(4-hydroxy-3-methylphenyl)fluorene and a dihydroxy component.

This lamp lens reflector is formed of a polycarbonate copolymer obtained by mixing 5-95 mol.% of a full aromatic dihydroxy component consisting of 9,9-bis(4-hydroxy-3-methylphenyl)fluorene and 95-5 mol.% of a dihydroxy component represented by the

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formula. In the formula R1-R4 each independently represents hydrogen atom, a 1-9C hydrocarbon group which may contain aromatic group, or halogen, W represents a single bond, a 1-9C hydrocarbon group which may contain aromatic group, O, S, SO, SO<sub>2</sub>, CO, or COO group. The compound represented by the formula is preferably 2,2-bis(4-hydroxyphenyl)propane.

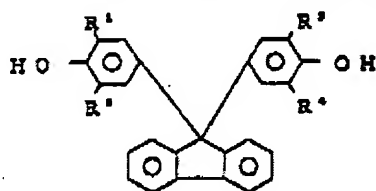
The reference **EP 1045261** discloses a retardation film comprised of a single oriented polymer film, characterized in that the retardation at wavelengths of 450 nm and 550 nm satisfies the following formulae (1) and/or (2), and the water absorption is no greater than 1%. where R(450) and R(550) represent the in-plane retardation of the oriented polymer film at wavelengths of 450 nm and 550 nm, respectively, and K(450) and K(550) are the values calculated by the formula disclosed herein (where  $n_x$ ,  $n_y$  and  $n_z$  represent the three-dimensional refractive indexes of the oriented polymer film as the refractive indexes in the direction of the x-axis, y-axis and z-axis, respectively, and  $d$  represents the thickness of the film) for the oriented polymer film at a wavelength of 450 nm and 550 nm, respectively. There are provided laminated retardation films and liquid crystal display devices employing the retardation film.

The reference **WO 01/73780** discloses a protective coat for an optical recording medium comprises one sheet of transparent film comprising a thermoplastic resin and exhibits a phase difference of 15 nm or less and K value of 40 nm or less both at a wavelength of 550nm, a glass transition temperature of 120 C or higher and a water absorptivity of 1 wt% or less.

The reference **EP 1195758** discloses an optical recording medium protecting film which is a protecting film comprising a single transparent film made of a thermoplastic resin, having a retardation of no greater than 15nm at a wavelength of 550 nm and a K value of no greater than 40 nm at 550 nm, having a glass transition temperature of 120 C or higher and a water absorption of no greater than 1 wt%.

**EP 0722099** discloses mirror having improved resistance to heat distortion and loss of dimensional stability when exposed to heat radiation. The mirror has a substrate of glass or plastic having front and back surfaces which can be of similar or different shape, and is coated with similar or dissimilar low-emissivity reflective layers on both surfaces. Radiation is reflected by the back surface (away from the mirror) thereby reducing the amount of energy which is absorbed at the back surface of the mirror. This equalizes the temperature through the mirror and reduces thermally-induced warping of the mirror.

**JP 02304741** an optical disk having small retardation, excellent optical homogeneity and high read-out sensitivity for the information recorded t herein by using a specified polycarbonate resin and/or polyformal resin as a substrate. Polycarbonate resin and/or polyformal resin derived from 20 - 90 wt.% bis-fluorene compound expressed by formula I is used as a substrate. In



formula I,

represents H or lower alkyl or phenyl group with C<sub>1-4</sub>. Thereby, the obtained.

optical disk has excellent shock resistance, heat resistance, moisture resistance, transparency, small retardation and excellent optical homogeneity, high read-out sensitivity of information and high reliability.

**WO 01/11612** discloses a tray for conveying the magnetic head for a magnetic disk has an arm parts (111), head tips (112) fixed to the ends of the arm parts and lead wires linked to the head tips. The tray is formed by molding a conductive thermoplastic

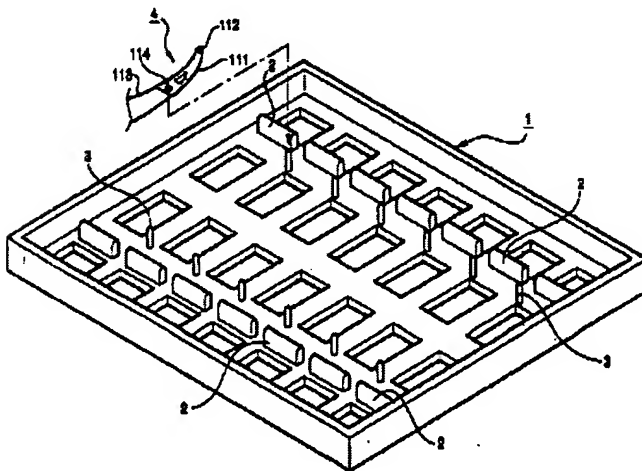
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resin composition. The reference mentions that when immersing the tray in 500 ml pure

water and applying ultrasonic waves of 40 kHz for 60 seconds, the number of particles of at least 1  $\mu\text{m}$  particle size which are lost from the surface of the tray is at most 5000 pcs/cm<sup>2</sup>.

The tray is used for conveying the magnetic head for a magnetic disk. The tray suffers few physical and chemical changes such as electrical damage due to electrostatic discharge and flowing of excessive contact current, loss of particles and contamination due to ions.

The diagram shows the tray.



Each of the references discloses a polycarbonate prepared from the same components as claimed by applicants. Any properties or characteristics inherent in the prior art, e.g. although unobserved or detected by the reference, would still anticipate the claimed invention. Note In re Swinehart, 169 USPQ 226. "It is elementary that the

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mere recitation of a newly discovered...property, inherently possessed by things in the prior art, does not cause claim drawn to those things to distinguish over the prior art". Since the disclosed parameters, flexural modulus, tan measured, deflection temperature etc. are expressed differently and thus may be distinct from those claimed, it is incumbent upon applicant(s) to establish that they are in fact different and whether such difference is unobvious. In view of the above, there appears to be no significant difference between the reference and that which is claimed by applicant(s). Any differences not specifically mentioned appear to be conventional. Consequently, the claimed invention cannot be deemed as novel and accordingly is unpatentable.

### **Correspondence**

**Please note that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site ([www.uspto.gov](http://www.uspto.gov)), from the Office of Public Records and from commercial sources. Applicants may be referred to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Terressa Boykin whose telephone number is 571 272-1069. The examiner can normally be reached on Monday through Friday from 6:30am to 3:00pm.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. The general information number for listings of personnel is ( 571-272-1700).

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tmb

  
**Examiner Terressa Boykin**

**Primary Examiner**

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